

Remarks

1) Claims 3 – 46 were pending in the case. By the Office Action mailed February 21, 2002 formal rejections under 35 USC 112 were made against claims 4 and 13 – 46; the Examiner made further rejections of claims 3 – 7 and 12 under 35 USC 102 in light of “Johnson”; and further rejections of claims 8 – 10, 12 – 15, 17, 18, 20, 21, 23 – 26, 28 – 37, 39 – 42, and 44 – 46 were made under 35 USC 103 given “Johnson” in light of Black, Jr., and Bell.

The Examiner indicated that claim 11 was allowable, and that claims 16, 19, 22, 27, 38 and 43 would be allowable if amended to overcome the rejections under 35 USC 112.

2) Office Action Incomplete

The office action of February 21, 2002 is incomplete for the following reasons:

The “Johnson” Reference

There appear to be two Johnson references of record in this case, namely US Patent 3,161,153 issued December 15, 1964 to J.A. Johnson; US Patent 3,004,500 issued October 17, 1961 to J.A. Johnson, both cited by the applicants in the Information Disclosure Statement filed on 29 October 2001, which is after the mailing on 7 May 2001 of the first Office Action from the Examiner. In the response making the final rejection, the Examiner has neither acknowledged review of the Information Disclosure Statement nor stated with sufficient specificity which of the two “Johnson” references he is relying upon. The Examiner has cited neither Johnson reference on the Notice of References Cited with the first Office Action, and has not included a Notice of References Cited with the second Office Action, in which the final rejection is made. The Examiner has a duty to identify upon which of these references the Examiner relies. The problem with the Examiner citing references only by the name of the inventor is going to be further exacerbated by the IDS being filed with this paper, as it includes a third US patent by an inventor named Johnson, in this case, US Pat. No. 3,362,353.

In order to make a proper reply to the Office Action, the applicants have assumed that the Examiner is referring to US Patent 3,161,153 to Johnson, since it has Figs. 1-8 and Johnson ‘500 has only Figs. 1-3.

3) 35 USC 1.83 (a) – Objection to Drawings

The Examiner has objected that claim 19 refers to a plastic pad mounted to the bottom flange of the bridge plate. This feature is presently shown in Figure 4b, as item 211. The applicant respectfully submits that no amendment to the drawings is required at this time.

4) 35 USC 112 – Formal Objections

Claim 4

The Examiner has again objected to the wording “the set of fittings” as lacking proper antecedent basis. The applicant again respectfully traverses the Examiner’s rejection. The wording used by the applicant in claim 4 has the classic form of a *Markush* claim sanctioned by the USPTO. (*Ex parte Markush* [1925] C. D. 126; O.G. 839).

The Examiner has now twice objected to a form of claim drafting that has been accepted practice in the USPTO for nearly 80 years. In that light, the applicant respectfully requests that the Examiner re-acquaint himself with proper practice for drafting *Markush* claims. The applicant commends to the Examiner s. 57 of the text *Landis on Mechanics of Patent Claim Drafting*, by Robert C. Faber, published by the Practicing Law Institute.

In the event that the Examiner is unwilling to acknowledge that this rejection under 35 USC 112 has been made in error, as clearly it has, the applicant respectfully requests that the Examiner identify, with precision, (a) the statutory provision, regulation, or caselaw upon which the rejection is founded; and (b) that the Examiner identify, according to standard rules of English grammar, with reference to the syntax of the claim as presently drafted, the grammatical error in the claim that forms the root cause of the Examiner’s rejection.

If the Examiner can identify, with precision, a grammatical or syntactical error in the claim, the applicant will gladly amend the claim to overcome that error.

Similarly, the Examiner’s objections under 35 USC 112 concerning the collar and the pivot pin do not appear to be properly made since one integer of a set in a *Markush* claim, by definition, does not provide antecedent basis for any other integer in the set. In that light, the applicant submits that the Examiner’s rejection on this ground is inconsistent with the long accepted practice of the USPTO. The applicant respectfully requests withdrawal of the current rejection of claim 4 under 35 USC 112.

Claim 13

The Examiner has again rejected claim 13 under 35 USC 112.

As explained in the previous response submitted by the applicant in this case, there is no combination/subcombination "problem" with claim 13. The applicant respectfully traverses the other rejections of claim 13 made by the Examiner under 35 U.S.C. 112. Claim 13 is clearly a claim to the sub-combination of a bridge plate. The grammatical structure of the claim admits of no other interpretation. It is neither a claim to a railroad car, nor to a combination of rail road cars. The claim is correctly written as it presently stands.

The rail road cars are noted in the preamble of the claim to provide environment. Subsequent reference in the claim to the environmental objects of the preamble is permitted, and desirable, to give greater understanding of the context of the invention, without incorporating the environment into the claim in such a manner as to convert a sub-combination claim into a combination claim. Such reference has been accepted U.S.P.T.O. practice since at least as long ago as *In re Rohrbacher and Kolbe* (128 U.S.P.Q. (BNA) 117 (C.C.P.A. 1960)) and *In re Dean* (130 U.S.P.Q. (BNA) 107 (C.C.P.A. 1961)). As such the applicant respectfully submits that any rejection under 35 USC 112 has been overcome.

In the event that the Examiner is unwilling to acknowledge that the current rejection of claim 13 under 35 USC 112 is without foundation, the applicant respectfully requests that the Examiner demonstrate, according to standard rules of English grammar,

- (a) where there is any possible ambiguity in the claim; or
- (b) where there is any grammatical or syntactical error in the claim.

The applicant further submits that the same considerations apply to the Examiner's comments on combinations and sub-combinations with respect to claims 20 and 24.

Claim 20

As previously indicated, Claim 20 is a claim to a sub-combination, namely to the bridge plate. It is not a claim to a rail road car. The applicant repeats the commentary made above in connection with claims 13 concerning combinations and sub-combinations.

There is no combination/subcombination "problem" with claim 20. The grammatical structure of the claim is both clear and correct. If the Examiner is unwilling to acknowledge that the rejection of claim 20 under 35 USC 112 has been made in error not merely once, but twice, the Examiner is respectfully requested to identify, with precision, and in accordance with standard rules of English grammar:

- (a) any improperly used verb;

- (b) any improperly used noun;
- (c) any improperly used modifier;
- (d) any other the grammatical error; or
- (e) any syntactical error,

upon which the Examiner purports to found the rejection of claim 20 under 35 USC 112.

The applicant respectfully submits that there is no basis in either law or grammar for the rejection of claim 20 under 35 USC 112.

The Examiner has again questioned the phrase “said second fitting including a linear extension member”. The slot itself defines a “linear extension member”, as indicated in the disclosure at page 20, lines 27 - 30. Again, there is no basis in either law or grammar for the Examiner’s continued rejection of the claim under 35 USC 112.

Claim 24

As previously explained, Claim 24 is a claim to a sub-combination, namely to the bridge plate. It is not a claim to a rail road car. The grammatical structure of the claim is both clear and correct in this regard. It admits of no other reasonable interpretation. The applicant repeats the commentary made above in connection with claims 13 concerning combinations and sub-combinations. The applicant respectfully submits that there is no basis in law for the Examiner’s current rejection of claim 24, and that the purported rejection under 35 USC 112 was clearly made in error.

In the event that the Examiner is unwilling to acknowledge that the rejection of claim 24 under 35 USC 112 was made in error, the Examiner is again respectfully requested to demonstrate:

- (a) a substantive basis in law, whether in the statute, the regulations or caselaw, upon which the rejection is based; and
- (b) according to standard rules of English grammar, which precise words in the claim are improperly used, and why.

The applicant respectfully requests that each and every one of the foregoing unfounded rejections of claims 4, 13, 20, 24 or any other claim, purportedly made under 35 USC 112 be withdrawn.

Claim 29

The Examiner has noted a typographical error in the claim. In that regard "tow" has been deleted and "two" has been inserted in the claim as suggested by the Examiner. The applicant had intended to make this amendment in the previous response to office action, but inadvertently deleted the amendment to claim 29.

Claim 33

In light of the Examiner's comments, and since it causes no loss of claim scope, the applicant has deleted the words "for a vehicle carrying rail road car" and the word "wheeled" from claim 33.

5) Rejections Under 35 U.S.C. 102 - Anticipation

(i) Test for Anticipation

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

(ii) U.S. Patent 3,161,153 of Johnson

Johnson Expressly Distinguishes Invention

The applicant has assumed that the Examiner intended to refer to US Patent 3,161,153 of Johnson.

Johnson'153 clearly does not have the features of the claim. The claim pertains to a bridge plate that is capable of staying in position spanning the gap between adjacently coupled rail road cars while the train is in motion.

Johnson'153 makes plain that his invention does not do this (col. 1, ln.59 – col. 2, ln. 2):

"Also, if the plates were left in operative position they would interfere with railroad personnel in operating the couplings between cars and would frequently be caught

between the ends of adjacent cars and damaged while the train of cars was negotiating railway curves. The bridging plates thus had to be mounted in a suitable manner, as by hinges, for freedom of vertical movement of the free ends of the plates. In addition to having the free or distal end vertically movable, the plates also had to be movable between an operative position in which they would span the corresponding gaps between adjacent car ends and *an inoperative position in which they are out of the way of railroad operating personnel, and in which they cannot be caught between adjacent car ends or [on ?] curves and damaged.*" (Emphasis added).

The central point of Johnson's invention is that it permits motion of the bridge plate to the inoperative position without the degree of lifting associated with raising and lowering drawbridge style bridge plates. The inoperative position is the position employed when the train is rolling along the rails. There is no suggestion that Johnson's bridge plates are deployed during train operation, quite the contrary.

Given that this is Johnson's invention, and given Johnson's disclosure not only does Johnson'153 not anticipate claim 3, or any other claim presently pending in the case, but rather, Johnson'153 teaches away from the present invention, the applicant submits that no grounds have been established for a rejection under 35 USC 102.

The applicant therefore requests that the rejection under 35 USC 102 be withdrawn, and claim 3 allowed, and that dependent claims 4 – 7, rejected on the same basis, now also be allowed.

6) Claim Rejections Under 35 U.S.C. 103 – Obviousness - Law

(a) MPEP Section 2142: Basic Requirements of a *Prima Facie* Case of Obviousness

Section 2142 of the Manual of Patent Examining Procedure (MPEP) states:

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir 1991).

(b) Mere Possibility of Combination is Not Sufficient

Section 2143.01 of the Manual of Patent Examining Procedure (MPEP) states:

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

(c) **Must Have Teaching, Suggestion, or Incentive to Combine**

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention *absent some teaching, suggestion or incentive* supporting the combination *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F. 2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir.). Cited in *In re Geiger*, 815 F.2d at 688, 2 USPQ 2d at 1268 (Fed. Cir. 1987) (Emphasis added). See also *In re Lee*, (61 USPQ 2d 1430 (CAFC, 2002)).

Obviousness cannot be established by combining references without also providing objective evidence of the motivating force that would impel one skilled in the art to do what the patent applicant has done (See *In Re Lee, infra*; see also *Ex Parte Levingood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993)).

(d) **Inquiry Must Present a Convincing Line of Reasoning**

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed toward obvious subject matter, either the references must expressly or impliedly, suggest the claimed invention or *the examiner must present a convincing line of reasoning* as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex Parte Clapp*, 227 USPQ972, 973 (Bd. Pat. App. & Inter. 1985) (Emphasis added).

When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex Parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)."

(e) **Inquiry Must Be Thorough And Searching**

"The factual enquiry whether to combine the references must be thorough and searching. *Id.*, It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. . . .

"The need for specificity pervades this authority. See e.g.,

"*In re Kotzab* 217 F. 3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.");

In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.");

In re Fritch, 972 F. 2d 1260, 1265, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references")."

(*In re Lee*, 61 USPQ 2d 1430 (CAFC, 2002). Emphasis and paragraph division added.)

Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee, supra*).

(f) "Would have been obvious to one skilled in the art"

The MPEP requires that the examiner provide an objective source of support for a contention that a feature is known or obvious to one skilled in the art. An unsupported statement that a feature or combination "would have been obvious to one skilled in the art" is improper if made without support. *In re Lee, supra*, and *In re Garrett* 33 BNA PTCJ 43.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made because references relied upon teach that all aspects of the claimed invention were individually known in the art" is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). See also *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide suggestion to combine references).

(g) Destruction of Function

"If proposed modifications would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

(h) "Obvious to one of ordinary skill in the art"

In several instances the Examiner has suggested that modifications are "obvious to one of ordinary skill in the art". The applicant respectfully traverses each and every such instance. As noted in *In Re Lee* and *Re Garratt*, a rejection under 35 USC 103 is not properly made out by an unsupported statement that it is "obvious to one of ordinary skill in the art". The Examiner bears the burden of providing support for such a rejection. In view of the authorities cited above, the Examiner has not provided adequate support either for the statement of what would have been 'obvious to a person skilled in the art', contrary to the holding in *Garratt*, or to provide suggestion for the combination, as in *Levengood*. As such the applicant respectfully submits that requirements for a rejection under 35 U. S. C. 103 have not been met.

7) The Cited References

Commentary re: US Patent 5,782,187 of Black, Jr.

The Examiner has repeated in the Office Action of February 21, 2002 the commentary of the Office Action of May 7, 2001 with respect to the Black Jr., reference (US Patent 5,782,187). The Examiner states:

"The general concept of using fittings with pivot pin [sic] engageable in a collar at either one or both ends of a bridge plate assembly of two rail road car units is well known in the art as illustrated by Black Jr., et al, see figs 5 – 9, abstract section, col. 1 – 2 lines 49 – 51."

The example cited by the Examiner in Black Jr., shows permanently mounted bridge plates located between two car units of an articulated rail road car. This is not the same as the present invention at all.

The aspects of the invention presently claimed relate to a bridge plate for use at the coupled end of a rail road car, to span the gap between vehicle decks at the couplers. As explained in the background of the invention at page 4, lines 21 – 34, the internal bridge plates mounted at a permanent articulated connector of an articulated rail road car face quite different design criteria and operating requirements than bridge plates at the coupler ends.

Figures 5 – 9 of Black Jr., cited by the Examiner, show an internal bridge plate. They do not reveal anything about the coupler end bridge plates. The Abstract makes no reference whatsoever to coupler end bridge plates. Indeed, the Abstract makes it abundantly clear that the bridge plates cited by the Examiner are “over the articulation between interconnected railway car units”. The Examiner has not identified where in the vast amount of text in col. 1 – 2 lines 1 – 67 there is support for the Examiner’s position. However, Black Jr., repeatedly states that the bridge plates are between pivotally interconnected units, supporting the argument presented by the applicant.

In this regard, the applicant specifically notes that the Examiner’s description in the Examiner’s report mailed May 7, 2001 is incorrect in stating that Black Jr., shows “... a beam 32 of sufficient length to span a gap between a pair of adjacent railroad cars (22a, 22b), ...” Items 22a and 22b are not adjacent rail road cars. On the contrary, car units 22a and 22b are units of a single articulated rail road car, 22 as plainly indicated by Black Jr., at, for example, col. 2, lines 10 – 12.

In the context of claim 13, this fundamental conceptual difference is emphasised not only by the intended use between two releasably coupled rail road cars, but further by indicating that one of the fittings is disengageable. Clearly, the Black Jr., bridge plate is not intended to be disengageable, but appears to be intended as a permanent element of the car. That is, not only is plate 32 retained by items 102a and 102b, (see Figure 8) but the entire plate is sandwiched between the permanently mounted movable platforms 30a (or 30b) and the underlying structure of the body of the car unit, be it 22a or 22b (See Figure 2). It is not surprising that plates 32 should be permanent – they are located at the permanent connection at the articulated connector.

Similarly, in the context of claim 24, again, Black’s bridge plates are not used at the coupler ends of the car. As such, the Black does not have a disengageable pivot pin, but rather connections that appear to be intended to be permanent mountings.

Re: Incentive to Combine Johnson ‘153 and Black Jr.

(i) Reasoning in Office Action is Based on Mistaken Premise (No. 1)

The Examiner states “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Johnson to include the use of pivot fittings with pivot pin [sic] engageable in a collar at either one end or both ends of a bridge plate assembly of his advantageous bridge plate assembly as taught by Black Jr., et al., in order to reduce the risk of

failure in the plate at the pivot point by sharing the load across the bridge plate thereby reducing maintenance cost of the system."

The applicant specifically notes that at no time has the Applicant suggested that the provision of pivots at either end of the bridge plate has anything to do with either (a) "risk of failure in the plate"; (b) "sharing the load across the bridge plate"; or (c) "the maintenance cost of the system."

In the embodiment disclosed, for example, the pivot pins have roughly vertical axes. The principle load borne by the bridge plate, and the by far the largest load to which the bridge plates are subjected during their service life, is the vertical load imposed when loaded wheeled vehicles are conducted across the bridge plate. That vertical load acts parallel to the axes of the pins, and the pins in the embodiment disclosed are vertically slideable to permit removal. The applicant is therefore at a loss to understand how the Examiner could infer that the pins could bear any significant load due to the vertical loading of the bridge plates. This is particularly so when the bottom flange of the bridge plates bears on a large planar area on each of the end portions of the adjacent rail road cars, into which planar areas the vertical load is distributed.

By contrast, the maximum radial load to which the pins are subjected is related to their own weight, the weight of the transition plates (if any) resting on them, and the co-efficients of friction between the plates and the supporting shelf and between the transition plate (if any). This load is very, very small compared to the vertical load. In that light, there does not seem to be a basis for the Examiner's commentary. In summary, the motivation posited by the Examiner for making the combination (a) is not supported by anything in the references themselves; and (b) is, as explained above, simply wrong as an analysis of the physical forces acting on the assemblies shown and described in the present disclosure. In summary, the applicant submits that the Examiner's reasoning is based on a mistaken premise.

(ii) Johnson '153 and Black Jr.: References Teach in Opposite Directions - No Motivation to Combine

This commentary assumes that the Examiner probably intended to cite Johnson '153.

The function of the pivot pins is that they provide a passive means by which to maintain the orientation of the bridge plates in position during motion of the train generally. It is this fact that lies at the root of the reason why a person skilled in the art would understand not to combine Black Jr., and Johnson '153: Black Jr., uses pivots because the internal bridge plates stay permanently in place. (But, of course, Black Jr.'s fittings are for internal bridge plates mounted adjacent to a permanent, slackless connection at an articulated connector). By contrast, Johnson

'153 teaches against leaving bridge plates in position at the coupler ends during train operation. These are mutually exclusive propositions: Black (in the context of internal bridge plates) says, in effect, "always leave them in place"; Johnson says, in effect, "never leave them in place". As these two propositions appear to be opposites, the applicant submits that they teach away from each other, and therefore teach away from the combination proposed in the office action.

Put differently, there would be no point putting a pivot fitting in the distal end of a beam that never undergoes yawing motion with respect to the adjacent deck. It would simply add unnecessary complication to the assembly.

To the extent that the Examiner has made an omnibus objection to claims 8 – 10, 12 – 15, 17 – 18, 20 – 21, 23 – 26, 28 – 37, 39 – 42, and 44 – 46 based on the modification of Johnson '153 in light of Black Jr., on the mistaken rationale discussed above, the applicant submits that no suggestion, motivation, or incentive to make the combination has been provided. On the contrary, to the extent that Black Jr., and Johnson '153 teach away from each other the applicant submits that no basis for a *prima facie* rejection of any of the above enumerated claims has been established under 35 USC 103. The applicant therefore respectfully requests withdrawal of the rejection and allowance of those enumerated claims.

Commentary Re: US Patent 4,721,426 of Bell

Reasoning in Office Action is Based on Mistaken Premise (No. 2)

In the Examiner's large, omnibus rejection, noted above, the Examiner further proposes the combination of Bell with Black Jr. and Johnson (presumably Johnson '153).

The Examiner has cited the Bell reference thusly:

"Also, the general concept of using traction bars on the top surface of an aluminum bridge plate assembly of two railroad car units is well known in the art as illustrated by Bell et al, see fig. 1, column 1, lines 60 – 67, column 2, lines 49 – 51."

and further,

"It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Johnson to include the use of traction bars on the top surface of an Aluminum bridge plate assembly in his advantageous bridge plate as taught by Bell et al., ..."

The Examiner's statements founder on the fundamental factual problem that the Bell reference does not show traction bars.

- (i) The first location cited by the Examiner is fig. 1. Figure 1 shows a top view of a relatively conventional channel. There are no tread bars shown in this view.
- (ii) The second location cited by the Examiner is column 1, lines 60 – 67. They read as follows:

Referring to FIG. 3, the cross-section of the plate between the hinged end and the tapered dock end includes several trusses partly responsible for being able to construct the plate entirely of aluminum and of minimum thickness at that."

There are no tread bars referred to in this quotation.

- (iii) The third location cited by the Examiner is column 2, lines 49 – 51. Column 2, lines 49 – 51 read as follows:

"The brace plate should also maintain a flat dimensional integrity for tread surface 12. This construction ..."

There is no mention of tread bars here either. On the contrary, the reference to tread surface 12 is to the upper smooth surface of the plate upon which wheeled vehicle can roll, and which lies flat. There are no tread bars mounted to surface 12.

In conclusion, the cited Bell reference simply does not show the features alleged by the Examiner, and upon which the Examiner bases his rejections. To the extent that those rejections are founded on a false premise, the applicant respectfully submits that no basis for a *prima facie* rejection under 35 USC 103 has been established. Therefore the applicant respectfully requests withdrawal of the rejection and allowance of each and every claim so rejected. in that connection, the applicant notes that it is not possible to determine to which of the long list of claims provided by the Examiner the Bell reference is considered relevant.

- (iii) Omnibus Rejection Does Not Identify Which Art Applies To Specific Claims

In the event that the Examiner upholds the rejection of one or more of the enumerated list of rejected claims, the applicant respectfully requests that the Examiner indicate, claim by claim, which of the references are thought to be applicable. An omnibus rejection, such as made in the present instance, does not permit the applicant accurately to understand the basis for the rejection of each claim, and unfairly impairs the applicant's ability to make a fair and full response to the rejections.

8) Commentary Related to Specific Claim Groupings

Claim 3 and Claims Dependent Therefrom

The Examiner has cited the combination of Johnson, Black Jr., and Bell against claims 8 – 10 and 12, which depend from claim 3.

(i) No suggestion Motivation or Incentive Demonstrated

The applicant notes that the Examiner has failed to identify any feature in any of the cited references from which a person skilled in the art would infer there to be a suggestion, motivation, or incentive to combine the cited references to arrive at the invention of any of claims 8 – 10 and 12. As such no *prima facie* ground for rejection has been established under 35 USC 103. On that ground alone the applicant respectfully requests withdrawal of the current rejection of claims 8 – 10 and 12.

(ii) 35 USC 103 and US Patent 3,161,153
Johnson'153 Teaches Away From Invention

Given that, as discussed above in the context of rejections made under 35 USC 102, Johnson '153 teaches away from the claimed invention of claim 3, there can be no motivation, suggestion, or incentive to employ Johnson in any way to arrive at the presently claimed invention of claim 3 or any claim dependent claim therefrom, including claims 8 – 10 and 12.

All of the current rejections under 35 USC 103 employ Johnson as the primary reference, and given that Johnson '153 expressly teaches away from leaving the bridge plates in place during train operation, the applicant submits that none of those rejections are supported by Johnson '153. The applicant submits that *prima facie* grounds for rejection under 35 USC 103 have not been established and requests that the rejection be withdrawn and the claims allowed.

Claim 13 and Claims 14, 15 and 17 - 18 Dependent Therefrom

(i) No Suggestion, Motivation, or Incentive to Combine.

As noted above, the Commissioner bears the burden of identifying a source of suggestion, motivation, or incentive to combine or modify the references as proposed in the Office Action. It is amply evident that no such source is identified in the Office Action of February 21, 2002. As such the applicant submits that *prima facie* grounds for rejection have not been established under 35 USC 103. The applicant respectfully requests that the rejection of claim 13, and any claim dependent therefrom under 35 USC 103 therefore be withdrawn.

(ii) Johnson '153 Teaches Against Claimed Invention

The same commentary as applied above in the context of claims dependent from claim 3 applies to claim 13 and the claims dependent therefrom rejected by the Examiner, given that claim 13 and any claim dependent from it relates to a bridge plate that spans the gap between coupled rail road cars when the rail road cars are in motion. As such Johnson '153 clearly teaches against the combination proposed in the Office Action of February 21, 2002. The applicant therefore respectfully requests that the current rejection under 35 USC 103 be withdrawn and claims 13 – 15, 17 and 18 be allowed.

Claim 20 and Claims 21 and 23 Dependent Therefrom

(i) No Suggestion, Motivation or Incentive Given

The Examiner has not identified any indication in either of these references that provides a motivation, suggestion or incentive leading to their combination. As such, the applicant submits that a *prima facie* ground for rejection of these claims on the basis the combination of the references, has not been made out under 35 U.S.C. 103.

(ii) Johnson '153 Teaches Against Invention

Claim 20 indicates that the second pivot fitting is tolerant of yaw motion of the bridge plate relative to the second rail road car when the second pivot fitting is engaged thereto. Inherently, this implies that yawing motion can occur while the second pivot fitting is so engaged, i.e., the railroad cars must be in motion. Clearly, that premise is antithetical to the teaching of Johnson '153: Johnson '153 indicates that it is inadvisable to leave bridge plates in the spanning position between rail road cars when the cars are in motion.

Claim 24 and Claims 25, 26 and 28 – 32 Dependent Therefrom

(i) No Suggestion, Motivation of Incentive Given

The Examiner has not identified where, or how, the references provides a motivation, suggestion or incentive leading to their combination. The applicant submits that a *prima facie* ground for rejection of these claims on the basis the combination of the references has not been made out under 35 U.S.C. 103. The applicant respectfully requests that the rejection of claim 24, and all claims dependent from it be withdrawn, and those claims allowed.

(ii) Johnson '153 Teaches Away From Invention

The premise of independent claim 24 is that there is a bridge plate kit that has first and second pivot fittings, and that the bridge plate is translatable relative to the axis of the second pivot fitting. This geometric premise has meaning if the first and second axes can move while the bridge plate is in position. (I.e., the second pivot fitting would tend to seem a pointless complication if the rail road cars are stationary. When the cars are stationary the conventional bridge plate, a ramp with a roughly square end lying on the adjacent deck, has proven satisfactory). As noted above, Johnson '153 teaches away from leaving bridge plates in place while the railroad cars are in motion. To the extent that the inherent function enabled by the second pivot fitting is to allow the bridge plate to stay in place during rail car operation, it is clear that Johnson '153 teaches away from the invention claimed in claim 24. As such, grounds for a *prima facie* rejection of claim 24, or any claim dependent therefrom have not been established under 35 USC 103. The applicant respectfully requests that the rejection of claim 24, and all claims dependent from it be withdrawn, and those claims allowed.

Claim 33 and Claims 34 – 37, 39 – 42, and 44 – 46 Dependent Therefrom

(i) No Suggestion, Motivation of Incentive Given

The Examiner has not identified where, or how any of the references provides a motivation, suggestion or incentive leading to their combination. As such, the applicant submits that a *prima facie* ground for rejection of these claims on the basis the combination of the references, has not been made out under 35 U.S.C. 103. The applicant respectfully requests that the rejection of claim 24, and all claims dependent from it be withdrawn, and those claims allowed.

(ii) Features of Claim Not Identified In Examiner's Rejection:

Proposed Combination Must Have All Claimed Features

Due to its omnibus nature, other than reciting a group including the claim number, it is not clear that the Examiner has addressed the specific application of the cited references to claim 33. In that regard, the Examiner's rejection does not identify all of the features of claim 33, and, equally so, does not identify in which of the references each of the various features is to be found. As such the applicant submits that no basis for a *prima facie* rejection of claim 33, or any claim dependent from it has been established by the Examiner. The applicant therefore respectfully requests withdrawal of the rejection of claim 33, and any claims dependent therefrom, namely claims 34 – 46, and requests allowance of those claims.

9) Obvious to One of Ordinary Skill in the Art

In several instances the Examiner has suggested that modifications are "obvious to one of ordinary skill in the art". The applicant respectfully traverses each and every such instance. As noted in *In re Lee* and in *Re Garratt*, a rejection under 35 USC 103 is not properly made out by an unsupported statement that it is "obvious to one of ordinary skill in the art". The Examiner bears the burden of providing support for such a rejection. In view of the authorities cited above, the Examiner has not provided adequate support either for the statement of what would have been obvious to a person skilled in the art, contrary to the holdings in *Lee* or *Garrett*, or to provide suggestion for the combination, as in *Levengood*. As such the applicant respectfully submits that requirements for a rejection under 35 U.S.C. 103 have not been met.

10) Examiner's Reply Commentary

The Examiner states:

"2. Applicant [sic] argument regarding a lack of teaching or [sic] suggestion or motivation to form the prior art to combine the references is not understood as motivation to combine the references *was provided in the rejection*. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F. 2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2.d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, one of ordinary skill in the art *would have found it obvious* to incorporate fittings with pivot pin [sic] engageable in a collar at either one end or both ends of a bridge plate assembly between two

cars as taught by Black Jr. et al., into Johnson in addition to inclusion of traction bars on the top of an Aluminum plate as taught by Bell et al., to construct the claimed invention for the various reason [sic] listed above; *as these prior arts [sic] establishes [sic] a prima facie case of obviousness that would suggest the claimed invention to an ordinarily skilled artisan.*" (Emphasis added).

(i) "...was provided in the rejection."

The applicant has carefully reviewed the Office Action mailed May 7, 2001. As far as the applicant can discern, there is nothing in the Office Action of May 7, 2001 that demonstrates motivation, suggestion or incentive to combine the references as proposed by the Examiner.

In the event that the Examiner continues to be of the view that such information is provided, the applicant respectfully requests:

- (a) that the Examiner indicate where in the Office Action of May 7, 2001 this information is provided, preferably by indicating the page, paragraph number, and a direct quotation of the exact words of the Office Action that are said to reveal this suggestion, motivation or incentive; and
- (b) an indication, by column and line number, or by Figure and item number, or both, of the location, or locations, in the references cited at which the Examiner derives the suggestion, motivation, or incentive to combine the references, with specific quotation of the relevant words, or a copy of the Figure, or Figures with the relevant portion, or portions, circled in red, for example, so that the applicant may know the basis for the current rejections.

(ii) "....would have found it obvious..."

The Examiner's statement was:

*"In the instant case, one of ordinary skill in the art *would have found it obvious* to incorporate fittings with pivot pin [sic] engageable in a collar at either one end or both ends of a bridge plate assembly between two cars as taught by Black Jr. et al., into Johnson in addition to inclusion of traction bars on the top of an Aluminum plate as taught by Bell et al., to construct the claimed invention for the various reason [sic] listed above; *as these prior arts [sic] establishes [sic] a prima facie case of obviousness that would suggest the claimed invention to an ordinarily skilled artisan.*" (Emphasis added).*

This is not a line of reasoning.

It is a conclusory statement by an Examiner.

Furthermore, it is a conclusory statement by an Examiner for which the Examiner has not identified the required support in the objective evidence of record. Conclusory statements by an examiner do not adequately address the issue of motivation to combine. (*In re Lee, supra*.) The case law requires that there be a “thorough and searching inquiry” that is based on “objective evidence of record.” (*In re Lee*) It is self evident that a bald, conclusory statement, such as made by the Examiner, provides neither.

It is the duty of the examiner to explain why the combination of the teachings is proper. (*Ex Parte Skinner, supra*). The applicant repeats the quotations cited above:

“*In re Kotzab* 217 F. 3d 1365, 1371, 55 USPQ 2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”);

In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”);

The applicant again submits that there has been no showing of any indication in the cited art of any suggestion, motivation, or incentive to combine the art as proposed by the Examiner.

The applicant further submits that there is nothing in the office action of May 7, 2001 or in the office action of February 21, 2002 that demonstrates “a thorough and searching inquiry”, support for the Examiner’s position in the form of “objective evidence of record”, or an explanation of why a skilled artisan “would have selected these components for combination in the manner claimed” as required by the caselaw cited above.

(iii) Incomprehensible Statement
Statement Inconsistent with the Law

- (a) The Examiner’s statement concludes with the following words:

" ... as these prior arts [sic] establishes [sic] a *prima facie* case of obviousness that would suggest the claimed invention to an ordinarily skilled artisan." (Emphasis added).

The applicant submits that this last portion of the Examiner's statement is either incomprehensible, inconsistent with the law, or both.

The applicant respectfully requests clarification of the Examiner's statement.

(b) The first part of the phrase asserts that the "these prior arts establishes a *prima facie* case of obviousness".

The very issue to be demonstrated by the Examiner is whether the art does, in fact, establish a *prima facie* case of obviousness. In order to demonstrate that it does for the purpose of founding a rejection under 35 USC 103, the law requires the Examiner to show how and why it does (*In re Kotzab; in re Rouffet*). Merely asserting that it does is of no probative value. The statement must be supported by objective evidence in the prior art. It is this objective evidence that the applicant submits is (a) required by law; and (b) entirely missing from both office actions (namely of May 7, 2001 and February 21, 2002). This is a repeated omission by the Examiner of an essential requirement of the test for obviousness. "Omission of an essential feature required by precedent is both legal error and arbitrary agency action." (*In re Lee, supra*). In place of the demonstration of objective evidence required by the caselaw, the office actions contain only an unsupported conclusory assertion by the Examiner. Clearly, that does not meet the standard required by law.

(c) The second aspect of the phrase appears to indicate that the suggestion for making the combination is found in the fact that the combination is obvious.

If that is what the Examiner is trying to say, then it is the opposite of the law.

A finding of obviousness is a legal conclusion. That legal conclusion flows from an analysis of the facts in light of the law, not the other way around. As part of the analysis, the law requires that a suggestion, motivation, or incentive be shown to make the combination, as a condition precedent for arriving at a conclusion that a claimed invention is obvious. This is an essential prerequisite of obviousness.

The Examiner cannot, therefore, purport to find a suggestion to make the proposed combination in the fact that the invention is obvious, and then find that the invention is

obvious because there is a suggestion that would lead a person skilled in the art to make the proposed combination. That is not the law.

(d) In the event that the Examiner upholds the current rejection of claim 1 under 35 USC103, the Examiner is specifically requested under MPEP 707.07(f):

- (a) to explain the meaning of the phrase "*... as these prior arts establishes a prima facie case of obviousness that would suggest the claimed invention to an ordinarily skilled artisan*";
- (b) to explain how this phrase is consistent with the law with specific reference to each of the cases cited above; and
- (c) to explain how this phrase has been applied to objective evidence in the prior art of record in this case to establish a rejection under 35 USC 103 in accordance with the law.

11) **General Commentary**

(1) The Commissioner bears the burden of preparing an office action in accordance with the law. Failure properly and fully to prepare an office action is unfairly and unreasonably prejudicial to the applicant (a) because it places the applicant in a position of not knowing with certainty the basis for the rejection of the claims; (b) because it foreseeably places unnecessary cost and inconvenience on the applicant; and (c) because it may ultimately deprive the applicant of substantive rights to which it is on merit entitled. This is contrary to basic principles of administrative law.

The applicant's ability to respond to an office action is severely handicapped when the applicant is not provided with clear and comprehensive reasons for rejection. Where the Examiner makes a rejection whose basis or meaning is unclear, the applicant must then guess what the basis for rejection is. As a principle of administrative law this is fundamentally unfair, and contrary to the CAFC holding in *In re Lee*.

(2) In making the rejections under 35 USC 103, the Examiner has not met the requirements set out in the caselaw, and has not followed the procedure set out in the MPEP.

In particular, the need for demonstration of a motivation, suggestion, or incentive to combine the references cited is an essential requirement for establishing a rejection under 35 USC 103. This has been established by statute and case law, and is reflected in MPEP 2142.

Conclusory statements by an examiner do not adequately address the issue of motivation to combine.

Omission of a relevant factor [*i.e.*, the essential requirement of showing suggestion, motivation, or incentive] required by precedent is both legal error and arbitrary agency action. - *In re Lee*.

"It is well established law that agencies [*i.e.*, including the Patent Office] have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action." - *In re Lee*.

"[A]n agency is not free to refuse to follow circuit precedent". - *In re Lee*.

"Reasoned findings are critical to the performance of agency functions..." - *In re Lee*.

(3) The applicant is entitled to receive, and the Examiner has the duty to prepare, office actions that has been prepared in accordance with the law. For the reasons demonstrated above, neither the office action of May 7, 2001 nor the office action of February 21, 2002 meets this standard. The Examiner is reminded that neither the Commissioner nor his delegates appointed to examine applications have the discretion to ignore the requirements of the law or to refuse to follow the precedent of the Court of Appeals for the Federal Circuit.

It is particularly troubling that the office action contains a statement such as the "Incomprehensible Statement", noted above. Quite aside from the plainly evident omission of essential elements of the test under 35 USC 103 discussed above, the "Incomprehensible Statement" appears to indicate that either the requirements under the law were not understood in the preparation of the office action, or that the law was improperly applied, or both. If so, none of the rejections under 35 USC 103 can be taken as having been properly made. If true, to the extent that they rely on an incorrect understanding of 35 USC 103, the inescapable conclusion is that the office actions of May 7, 2001 and February 21, 2002 were both flawed at their roots.

(4) In light of the foregoing, in the event that the Examiner upholds the rejection of one or more of the claims presently pending in this case the applicant again requests that, in conformity with the Examiner's duty under the law:

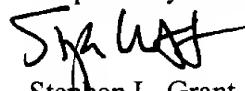
(i) that the Examiner identify *with specificity* which references are being cited against each specific claim, and the specific features in the references that are sought to be applied to each claim, by Figure and item number or by column and line number;

- (ii) that the Examiner address *by reasoned argument, and in specific detail*, each of the applicant's arguments;
- (iii) that, where a rejection is made under 35 USC 103, the Examiner identify, *with precision and in specific detail* (e.g., by way of Figure and item number, or by column and line number), the location in the references at which a suggestion, motivation, or incentive is provided to make the proposed combination.

12) **Conclusion**

In view of the foregoing arguments and claim amendments the applicant submits that the all of claims 3 – 46 presently pending in this case are in a condition to permit allowance. Therefore the applicant requests early and favourable disposition of this application.

Respectfully submitted,



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Date: 20 August 2002

VERSION WITH MARKINGS TO SHOW CHANGES MADE

29. (Amended) The bridge plate kit of claim 24 wherein said kit includes two of said bridge plates, two of said first fittings and [tow] two of said second fittings whereby said bridge plates, when installed, co-operate as a pair of side-by-side wheel trackways to define a pathway between the first and second rail road cars.

33. (Amended) A bridge plate [for a vehicle carrying rail road car], for use in permitting a vehicle to be conducted between respective vehicle decks of a pair of adjacently coupled first and second rail road cars, said bridge plate comprising:

a beam member for extending between the two adjacently coupled railroad cars, the beam member having a first end for engaging the first rail road car, and a second end for engaging the second rail road car;

said beam member having an upper flange, a lower flange, and webs extending between said upper and lower flanges to form a hollow section;

said upper flange of said beam member having a track surface upon which the [wheeled] vehicle can be conducted;

said first end of said beam member having a pivot fitting mounted thereto;

said pivot fitting permitting movement of said beam about a pivot axis normal to said track surface.